

**O-538-15**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 049 712 BY BLUE  
MOUNTAIN FOODS TO REGISTER (AS A SERIES OF TWO) THE TRADE  
MARKS: BLUE MOUNTAIN FOODS/BLUE MOUNTAIN FOOD IN CLASS 29

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No 402 998  
BY B M FOODS LIMITED

## Background and pleadings

1. Blue Mountain Foods (the applicant) applied to register (as a series of two) the trade mark BLUE MOUNTAIN FOODS/BLUE MOUNTAIN FOOD under Number 3 049 712 in the UK on 2<sup>nd</sup> April 2014. It was accepted and published in the Trade Marks Journal on 4<sup>th</sup> July 2014 in respect of the following goods in Class 29:

*Chilled and frozen ready to eat meals; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating].*

2. B M Foods Limited (the opponent) opposes the trade mark under Number 402 998 on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, its earlier UK Trade Mark.



The following goods are among those relied upon in this opposition:

Class 29:

*Prepared dishes consisting principally of meat; Prepared fruits; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes.*

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made. .
5. Both sides filed evidence in these proceedings. This will be summarised if it is considered appropriate.
6. The opponent is represented by Temple Bright LLP and the applicant is self represented.
7. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## DECISION

### Preliminary Remarks

8. In filing its counterstatement, the applicant argues that it was using its mark prior to the launch of the opponent's products. In this regard, the applicant's attention is directed towards Tribunal Practice Notice 4/2009 "Trade mark opposition and invalidation proceedings – defences", particularly the following:

**"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark**

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

As such, the claim from the applicant must be set aside.

### Section 5(2) (b)

9. Sections 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

### Comparison of goods and services

10. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

## O-538-15

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. The earlier goods include:

Class 29:

*Prepared dishes consisting principally of meat; Prepared fruits; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat dishes.*

The later goods are:

Class 29:

*Chilled and frozen ready to eat meals; Prepared meals consisting principally of game; Prepared meals consisting substantially of seafood; Prepared meals containing [principally] bacon; Prepared meals containing [principally] chicken; Prepared meals containing [principally] eggs; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating].*


## O-538-15

13. With the exception of *chilled and frozen ready to eat meals*, the contested goods all appear in the earlier specification expressed in an identical manner. Further, the contested *chilled and frozen ready to eat meals* are considered to be identical despite the slight variation in description: prepared meals and ready meals refer to the same thing. At the very least they are clearly highly similar.
14. The contested goods are therefore considered to be in the main, identical and/or in the case of ready meals, highly similar to those of the earlier trade mark.

### Comparison of marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”
16. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
17. The respective trade marks are shown below:

	<p>Blue Mountain Foods</p> <p>Blue Mountain Food</p>
<p>Earlier trade mark</p>	<p>Contested trade mark (series of two)</p>

18. In considering the respective distinctive and dominant components, it is considered that the earlier trade mark hangs together as a complete phrase with no one element being more memorable than the other. In respect of the contested trade mark it is Blue Mountain which is more memorable than foods/food as the latter is clearly descriptive of the goods in question which are foodstuffs.

19. Visually, the respective trade marks coincide in the words BLUE MOUNTAIN and differ in respect of the additional FOOD/FOODS in the later series of marks. The earlier trade mark is presented in a stylised font, but this does not matter<sup>1</sup>, the earlier mark is clearly BLUE MOUNTAIN. There is considered to be a moderate to high degree of visual similarity here.

20. Aurally, the marks coincide almost entirely. There is a high degree of similarity.

21. Conceptually, each trade mark conveys the idea of a mountain which is blue in colour. The addition of foods in the later trade mark does not detract from this as the foods are from a “blue mountain” with this being the overriding concept. They are conceptually identical.

### Average consumer and the purchasing act

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

<sup>1</sup> See case T-346/04 Sadas SA v OHIM

## O-538-15

23. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. The goods in question are consumables purchased frequently, possibly on a daily (most likely weekly) basis. The relevant consumer is the public at large. They will usually be purchased visually in a supermarket environment via self selection. The relevant consumer would be expected to display a lower than average degree of attention.

### **Distinctive character of the earlier trade mark**

25. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

26. There is no claim to an enhanced degree of distinctive character from the opponent and there is no evidence that BLUE MOUNTAIN has any meaning in respect of the goods. It is considered to be at least averagely distinctive.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive



## O-538-15

role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

28. The goods here have been found to be identical and/or highly similar. Further the marks are highly similar visually and aurally and are conceptually identical.

29. The earlier trade mark is at least averagely distinctive and coincides with the later mark in respect of its distinctiveness which centres around BLUE MOUNTAIN. In this regard, the following is taken into account: in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after

## O-538-15

that has been done can a proper assessment of the likelihood of confusion be carried out”.

30. It is also taken into account that the average consumer will display only a lower degree of attention during the purchasing process. Further, that the consumer rarely has the opportunity to compare marks side by side and instead relies on an imperfect picture of them. Bearing in mind all of the aforesaid, it is clear that direct confusion between the two marks is not only likely, it is inevitable.

### Final Remarks

31. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based.

### COSTS

32. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Opposition fee: £200

Considering counterstatement and evidence: £300

Filing written submissions: £300

TOTAL: £800

33. I therefore order Blue Mountain Foods to pay B M Foods Limited the sum of £800. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19th day of November 2015**

**Louise White**

**For the Registrar,**